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Our Case No. 8285/431

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Philip T. Kortum)
Serial No. 09/847,045) Examiner: Igor N. Borissov
Filing Date: May 1, 2001) Group Art Unit No. 3629
For Unified Digital Subscriber Line Self-)
Installation Process and Kit)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandra, VA 22313-1450

Dear Sir:

Applicants request review of the final rejection that was mailed October 5, 2006 in the above-identified application. No amendments to the claims are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

I. Introduction

Claims 1, 3-8, 10-16 and 18-20 are pending in the application. In the Office Action dated October 5, 2006, the Office Action maintained the rejection of claims 1, 5-8, 12-16 and 20 under 35 U.S.C. §103, as being unpatentable over the “SBC global network DSL: Customer Self Install” (“SBC Document”) in view of Klees (U.S. Patent No. 5,283,661). Claims 3-4, 10-11 and 18-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the SBC Document in view of Klees and further in view of Official Notice.

II. The Office Action does not correctly address elements of the claims that are not disclosed or suggested by the cited references

Neither the SBC Document nor Klees, alone or in combination, disclose or suggest the claimed “instruction manual which describes a unified installation process” in which the instruction manual provides “instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code”. The Office Action attempts to improperly read disclosure into the references to come to a contrary conclusion.

A. Claim 1

Pending independent claim 1 recites a digital subscriber line self-installation kit with “at most one instruction manual which describes a unified installation process which provides instructions to install all of the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code”.

Klees describes a method and apparatus for detecting that a facsimile machine is being installed, and has nothing to do with digital subscriber lines. The system of Klees uses information stored within the facsimile machine to aid the installer during installation and/or operation of the facsimile machine. The system uses either image and text information or verbal information stored in the memory of the facsimile machine. The system was put in place because purchasers of facsimile machines often found the instruction manuals difficult to read and only used them as a last resort. *See Klees Background*. The Office Action points to the Background of Klees for the proposition that it would have been obvious to include an instruction manual in the system of the SBC Document to simplify the installation process by providing an instruction manual to install all elements of the kit. This is a stretch of logic, however, since Klees does not disclose that at most one instruction module would be used.

Moreover, Klees is interested in removing the need for an instruction manual altogether. Klees discloses storing instructions into a read only memory (ROM) of the machine and automating the installation process to assist the user so that they do not have to rely on the manual. In addition, the facsimile system of Klees does not disclose or suggest the at most one instruction manual for providing instructions to install all of a digital subscriber line modem, digital subscriber line filter, and computer readable connection software code, as in claim 1. The facsimile machine of Klees has nothing to do with such components.

The SBC Document fails to fill the gaps of Klees. While the SBC Document related to installing digital subscriber lines, the Office Action correctly points out that the SBC Document does not describe at most one instruction manual for the installation process of the digital subscriber line. The SBC Document also does not disclose or suggest that the at most one instruction manual provides instructions to install all of the digital subscriber line modem, the at least one digital line filter, and the computer readable connection software. As described in the Background section of the application as filed, multiple instructions manuals, one for each different part of the system, were provided.

Therefore, for at least these reasons, Applicants respectfully request that the rejections to the claims be withdrawn.

B. Claim 8

Pending independent claim 8 recites a digital subscriber line self-installation kit with “at most one instruction manual which describes a unified installation process which provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code”. For at least the reasons discussed above with regard to claim 1, Applicants respectfully request that this rejection also be withdrawn.

C. Claim 16

Pending independent claim 16 recites a digital subscriber line self-installation kit with “at most one instruction manual which describes a unified installation process which provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, the computer readable connection software code and the computer readable internet service provider specific software code”. For at least the reasons discussed

above with regard to claim 1, Applicants respectfully request that this rejection also be withdrawn.

III. Dependent Claims

Dependent claims 3-4, 10-11 and 18-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the SBC Document in view of Klees and further in view of Official Notice. These claims include the features of their respective independent claims discussed above, plus additional feature. Therefore, for at least the reasons discussed above, Applicants respectfully request that the rejection to these claims be withdrawn.

Official Notice was taken by the Office Action that it is well known to provide goods ordered by customers in shipping containers. Furthermore, Applicants request that a reference be provided in place of the Official Notice regarding the features as claimed, e.g., the container that contains the digital subscriber line modem, the at least one digital subscriber line filter and the computer readable medium.

IV. There is No Motivation for the Proposed Combination of References

Moreover, there is no motivation to combine the facsimile machine installation system of Klees with the digital subscriber line customer self-install program of the SBC Document. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01.

Applicants maintain that it would not have been obvious to incorporate the features of the SBC Document with the Klees. The system of Klees describes a method and apparatus for storing information within a facsimile machine and automating the installation process to aid the installation of a single machine, i.e., the facsimile machine. The SBC Document relates to the installation of various, disparate components together to enable a digital subscriber line system, such as for use with the Internet.

In addition, there is no motivation to combine the digital subscriber line installation of the SBC Document with the facsimile machine system of Klees. The patent application as filed noted that a problem to be addressed by the claimed invention was that known self-installation kits included various disparate components, each with their own manual. There was a problem with self-installation kits in that a user may have been uncertain as to which manual, of the

multiple manuals, to read first. User testing showed that critical installation steps were often missed with such self-installation kits having multiple manuals. Further, conflicting information may have been present in different manuals since vendors typically constructed their manuals in isolation from each other. *See Background.* On the contrary, Klees describes the installation of a single component, a facsimile machine. There is no explicit or implicit teaching in either reference to combine the disclosed systems, such as to address these stated problems. Indeed, the system of Klees attempts to remove installation manuals from the system since such manuals are considered "difficult and unwieldy". Col. 1, ll. 14-16 of Klees. While both systems may generally relate to installations, the specific disclosed systems and installation processes described are very different from each other, and therefore it is inappropriate to combine the references.

For at least these additional reasons, Applicants respectfully request that the rejection be withdrawn.

IV. Conclusion

For at least the above reasons, Applicants respectfully request review of the final rejection directed against the current application and withdrawal of the rejections against the claims.

Respectfully submitted,



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